UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/596,473 | 06/14/2006 | Wilhelmus Franciscus Johannes Fontijn | NL031510 | 6999 |

24737 7590 12/23/2009
PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

| EXAMINER | |
|---|---|
| VAUGHAN, MICHAEL R | |
| ART UNIT | PAPER NUMBER |
| 2431 | |
| MAIL DATE | DELIVERY MODE |
| 12/23/2009 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/596,473 | FONTIJN, WILHELMUS FRANCISCUS JOHANNES | |
| | Examiner | Art Unit | |
| | MICHAEL R. VAUGHAN | 2431 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *29 October 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 June 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

The instant application having Application No. 10/596,473 is presented for examination by the examiner.

### *Priority*

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been received.

### *Drawings*

The drawings are accepted.

### *Specification*

The specification is objected to be it lacks the proper USP headings.

### *Claim Objections*

Claims 2-15 are objected to because of the following informalities:

Each of the dependent claims should refer to their parent claim as "the method" as opposed to "a method".

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6 and 10, are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. The method of claim 1 could be performed by hand. There is no explicit or implicit machine needed in carrying out the method of claim 1. Thus, the claims are non-statutory.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1-16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 1 and 16, the recitation of "and/or" causes an indefiniteness because the scope of the combination [and] and the alternative [or] is different. It is not clear whether both are required.

As per claim 9, the phrase "substantially immediately" is unclear.

As per claim 11, the phrase "more preferably" renders the claim indefinite.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 10, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 6,434,553 to Sekiguchi et al hereinafter Sekiguchi.

As per claim 1, Sekiguchi teaches a method of accessing and/or recording data content in a storage device, including the steps of:

(a) arranging for the data content on a data storage medium (col. 3, line 34) of the device to be a master file (MF) having an associated file name for identifying an address

range (col. 5, lines 1-3) for locating and subsequently accessing and/or recording said master file on the medium (col. 3, line 46);

(b) arranging for the master file to include substantially within its address range at least one sub-file having an associated file name for identifying an address range for locating and accessing and/or recording the sub-file on the medium (col. 3, lines 49-50); and

(c) at least one of reading data content from and writing data content to at least one of the master file and the at least one sub-file using their associated file names (col. 3, line 55).

As per claim 2, Sekiguchi teaches there is a plurality of sub-files arranged to be mutually non-overlapping (Fig. 1, elements 132, 133, 134).

As per claim 3, Sekiguchi teaches there is a plurality of sub-files of which a sub-set thereof is arranged to be mutually overlapping (Fig 1, files B, C, and D overlap file A; column 4, lines 63-65).

As per claim 10, Sekiguchi teaches the data storage medium is arranged to be detachable from the storage device (col. 3, lines 33).

As per claim 16, it is rejected for the same reasons as claim 1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4-8, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekiguchi in view of USP Application Publication 2002/0138593 to Novak et al hereinafter Novak.

As per claim 4, Sekiguchi is silent in explicitly teaching the sub-set of the at least one sub-file is in encrypted form. Novak teaches a sub-set of the at least one sub-file is in encrypted form (0084 and 0087). Novak teaches a file comprising subfiles are each encrypted with keys. Encryption is well known for its security applications. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to encrypt the files of Sekiguchi as disclosed by Novak for security reasons.

As per claim 5, Sekiguchi is silent in teaching the device is operable to access in sequence the sub-set of the at least one sub-file in encrypted form using corresponding decryption access keys. Novak teaches the device is operable to access in sequence the sub-set of the at least one sub-file in encrypted form using corresponding decryption access keys. Examiner supplies the same rationale as recited in the

rejection of claim 4 as to why the claim is obvious over the combination of Sekiguchi and Novak.

As per claim 6, Sekiguchi is silent in teaching the decryption keys are provided to the device from data serving means via at least one authenticated communication channel. Novak teaches the decryption keys are provided to the device from data serving means via at least one authenticated communication channel as the WMD file key is encrypted with the recipient's public key (0084). Public key cryptography is well known in the art. Examiner supplies the same rationale as recited in the rejection of claim 4 as to why the claim is obvious over the combination of Sekiguchi and Novak.

As per claim 7, Sekiguchi is silent in teaching the at least one authenticated communication channel is established between the device and said one or more remote data servers using private-public key encryption. Novak teaches the at least one authenticated communication channel is established between the device and said one or more remote data servers using private-public key encryption (0084). Examiner supplies the same rationale as recited in the rejection of claim 4 as to why the claim is obvious over the combination of Sekiguchi and Novak.

As per claim 8, Sekiguchi is silent in teaching the storage device is operable to establish said at least one authenticated channel with said data serving means for obtaining one or more decryption keys. Novak teaches the storage device is operable to establish said at least one authenticated channel with said data serving means for obtaining one or more decryption keys (0084). Novak teaches the decrypted keys are sent encrypted with the recipient's public key. Examiner supplies the same rationale as

recited in the rejection of claim 4 as to why the claim is obvious over the combination of Sekiguchi and Novak.

As per claim 12, Sekiguchi is silent in teaching the data content is arranged to correspond to executable software code included within the master file, wherein the sub-files, correspond to user-selectable options. Sekiguchi discloses general files and when it is known that selecting any file of the file group, it is faster to pre-fetch the others because they will also need to be opened. Novak teaching a container file which incorporates supporting files. It holds true that when selecting one of the files, the other files will need to be opened. Thus, this type of media container benefits from the teaching of Sekiguchi because of the similar architecture. Novak teaches the data content is arranged to correspond to executable software code (music tracks) included within the master file, wherein the sub-files, correspond to user-selectable options (skins, playlists, borders; 0078). It is obvious to combine the type of WMD file taught by Novak into the system of Sekiguchi because the WMD files are the kind in which Sekiguchi can open more quickly. The claim is obvious because combining known methods which produce predictable results is within the ordinary capabilities of one of ordinary skill in the art. Novak's files are one specific type of file which benefits from Sekiguchi's teachings.

As per claim 13, Sekiguchi is silent in teaching those sub-files included within the master file which are encrypted correspond to user-selectable software options accessible for execution to response to user-payment. Sekiguchi teaches those sub-files included within the master file which are encrypted (0084) correspond to user-

selectable software options (0078) accessible for execution to response to user-payment (0074). Examiner supplies the same rationale as recited in the rejections of claim 4 and 12 as to why the claim is obvious over the combination of Sekiguchi and Novak.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sekiguchi in view of non-patent publication "Small Form Factor Optical Drive: Miniaturized Plastic High-NA Objective and Optical Drive" authored by Braun et al., published in 2002, hereinafter, Braun.

As per claim 11, Sekiguchi is silent in teaching the storage medium is a miniature optical data storage disc, more preferably a SFFO disc. Braun teaches a storage medium is a miniature optical data storage disc, more preferably a SFFO disc (page 251). SFFO is just one type of known storage medium at the time of the invention. Therefore the claim is obvious because combining known methods which produce predictable results is within the ordinary capabilities of one of ordinary skill in the art. One of ordinary skill in the art could have applied Sekiguchi's teachings to any type of storage medium.

Claims 14 and 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sekiguchi in view of USP Application Publication 2006/00118619 to Hulst et al hereinafter Hulst.

As per claim 14, Sekiguchi is silent in teaching the storage device is included as a part of a mobile telephone apparatus coupleable to a communication network. Hulst teaches storage device are part of a mobile telephone and allows content to be delivered to the storage device from the network (0017). Sekiguchi generally described a computer. However mobile phones are types of computers. The claim is obvious because combining known methods which produce predictable results is within the ordinary capabilities of one of ordinary skill in the art.

As per claim 15, Sekiguchi is silent in teaching the data content stored in the master file of the storage device is at least one of pre-recorded onto the storage medium and downloaded from said communication network. Hulst teaches the data content stored in the master file of the storage device is at least one of pre-recorded onto the storage medium and downloaded from said communication network (0017). Downloading file from a network is just one of the many ways known in the art to place a file into a storage medium. The claim is obvious because combining known methods which produce predictable results is within the ordinary capabilities of one of ordinary skill in the art.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sekiguchi and Novak as applied to claim 5 above, and further in view of USP Application Publication 2005/0074125 to Chavanne et al., hereinafter Chavanne.

As per claim 9, Sekiguchi and Novak are silent in teaching the device is arranged to destroy said at least one of the decryption keys received at the device after at least one of:

(a) a pre-determined time duration after receipt of the at least one key at the device; and (b) substantially immediately after its corresponding sub-file has been decrypted within the device for executing thereof. Chavanne teaches the device is arranged to destroy said at least one of the decryption keys received at the device after a pre-determined time duration after receipt of the at least one key at the device (0095). This functionality affords the content provider greater control over content. The combined system of Sekiguchi and Novak allow a user to purchase content from a provider. A pre-determined time duration of the content gives the service provider more control over its content. Deleting the decryption keys is one way of establishing and end to the time duration. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to delete the keys to limit the time duration of the content because it gives the service provider more control and allows it to offer more types of services. For example, one could download trail versions of content or rent content at a cheaper price.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is listed on the enclosed PTO-892 form.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL R. VAUGHAN whose telephone number is (571)270-7316. The examiner can normally be reached on Monday - Thursday, 7:30am - 5:00pm, EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on 571-272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. R. V./

Examiner, Art Unit 2431

/William R. Korzuch/

Supervisory Patent Examiner, Art Unit 2431